

Application No. 10/663,979

NOV 22 2006

Art Unit: 3714

REMARKS

In the Office Action, the Examiner objected to the specification and objected to claims 1-28. Each of the Examiner's objections is discussed below, along with an appropriate remedy.

5 Rejection for Informalities

The Examiner states that claims 2-26 use incorrect language to refer back to an independent claim with only one method. Specifically, claims 2-26 should disclose "The method of claim 1..." instead of "A method of claim 1...."

10 Applicant has replaced the 2-26 claims with claims 30 and 31 that use the appropriate language to refer back to an independent claim with only one method. Specifically, dependent claims 30 and 31 disclose: "The method of claim 29..."

The Examiner also states that claims 2-26 must depend in full upon a prior claim, not just a sub-section of the prior claim. Specifically, claims 2-26 should not refer to particular sub-section of claim 1.

15 Applicant has replaced the 2-26 claims with claims 30 and 31 that depend in full upon a prior claim, without reference to sub-sections. Specifically, claims 30 and 31 depend in full upon claim 29.

Thus, Applicant respectfully submits that claims 29-31 satisfy the formality requirements. Withdrawal of these objections is respectfully requested.

Application No. 10/663,979

Art Unit: 3714

Rejection Under 35 USC § 112, second paragraph – Indefinite Language

The Examiner states that claims 1, 25 and 26 contains indefinite language – “and/or” – that make it unclear whether the limitations following the objectionable language are part of the claimed invention.

5 Applicant has replaced claims 1, 25, and 26 with claims 29-31 that do not contain any of the indefinite language objected to by the Examiner. Specifically, claims 29-31 do not include the “and/or” phrase. Applicant respectfully submits that Claims 29-31 satisfy the requirements under 35 USC 112, second paragraph. Withdrawal of these objections is respectfully requested.

10 **Rejection Under 35 USC §102 – Anticipation**

The Examiner states that claims 1-4, 7, 8, 11-17 and 25-28 are anticipated by Bussick et al (US 7,070,502 B1; hereafter Bussick). Applicant respectfully submits that Bussick does not teach the same invention as the present application and provides no grounds for rejection, as discussed below:

15 Bussick teaches a two-step method of calculating awards in games with expanding wildcard symbols, with a first award calculation performed prior to wildcard expansion and a second award calculation performed after wildcard expansion.

In particular, the Bussick specification describes a method of operating a gaming device with “a wildcard symbol that affects other symbols in a same row, column or set as said wildcard symbol, and wherein the game exercises two evaluations in determining the player’s award.”
20 (Bussick at column 1, lines 18-21; emphasis added.)

Further, the Bussick claims describe a slot machine with two sets of symbols providing two separate award calculations, such that said game:

Application No. 10/663,979

Art Unit: 3714

5 ...provides an award to a player for each award yielding symbol combination in said first set... if said wild symbol occurs in the first set, said wild symbol causing a substitution of another one of the non-wild symbols in said first set with another wild symbol at of the plurality of generated symbols on the reel with the wild symbol to create a second set of symbol that is displayed in place of the first set of symbols and ... and additional award to the player for each award yielding symbol combination in said second set... (Bussick at column 16, lines 1-13; emphasis added.)

10 Bussick, therefore, teaches a method for calculating award values for expanding wildcard symbols. Although Bussick mentions the expansion of wildcard symbols, Bussick does not teach any method by which these wildcard symbols expand in the symbol matrix. And, even if Bussick were read to teach some method of wildcard expansion, Bussick does not disclose methods of wildcard expansion using pre-determined directions associated with each wildcard
15 symbol. Moreover, any method of wildcard symbol expansion under Bussick requires a two-step award evaluation process.

20 The present invention, however, teaches methods by which wildcard symbols expand in a symbol matrix, with each wildcard symbol expanding in one or more predetermined directions associated with that individual symbol. Further, the present invention only utilizes a single-step award evaluation for winning symbol combinations formed with expanded wildcard symbols.

25 The application includes descriptions of the methods by which a wildcard symbol may expand in a pre-determined direction in the symbol matrix, including a description of the preferred embodiment as a slot machine game using:

30 ...wild symbols that expand in a pre-determined vertical direction – upwards or downwards. The upwards wild symbol (“Up Wild”) converts all of the symbol positions above the Up Wild into wild symbols. The downwards wild symbol (“Down Wild”) converts all of the symbol positions below the Down Wild into wild symbols... (Directional Wild application, page 9, paragraph 2; emphasis added.)

Application No. 10/663,979

Art Unit: 3714

Further, the application also includes illustrated examples of wildcard symbols expanding in the predetermined direction associated with each wildcard symbol, with awards issued for winning symbol combination formed following the expansion of all wildcard symbols. (See Directional Wild application, Figures 4a-f, along with
5 accompanying descriptive text on pages 25-31.)

The present invention, therefore, teaches novel methods of wildcard expansion in the symbol matrix and uses a one-step award calculation for winning symbol combinations. Specifically, claim 29 describes the expansion of wildcard symbols in the one or more predetermined directions associated with each wildcard symbol and the issuance of awards
10 following expansion of all wildcard symbols; claim 30 specifies directions in which the wildcard symbol expansion may occur; and claim 31 specifies how far the wildcard symbol may expand in each direction.

Thus, Applicant respectfully submits that the objections to claims 1-4, 7, 8, 11-17 and 25-28 have been overcome by claims 29-31 and, therefore, these new claims satisfy the
15 requirements under 35 USC 102. Withdrawal of these objections is respectfully requested.

Rejection Under 35 USC §103 – Obviousness

The Examiner states that claims 5, 6, 9, 10 and 18-24 are unpatentable over Bussick et al. (US 7,070, 502 B1) in view of Rothchild et al. (US 6,786,818 B1), with regard to player
20 selection of the directions of wildcard symbol expansion, scatter pay methods, and bonus awards for overlapping symbols. (See Office Action, page 6, first full paragraph.)

Applicant has replaced claims 5, 6, 9, 10 and 18-24 with claims 29-31 that do not teach any of the methods listed by the Examiner as objectionable under 35 USC 103. New claims 29-

Application No. 10/663,979

Art Unit: 3714

31 do not provide player selection of expansion direction, do not provide scatter awards, and do not offer bonus awards for symbol overlapping.

Thus, Applicant respectfully submits that the objections to claims 5, 6, 9, 10 and 18-24 have been overcome by claims 29-31 and, therefore, these new claims satisfy the requirements under 35 USC 103. Withdrawal of these objections is respectfully requested.

Conclusion

In view of the foregoing remarks, Applicant respectfully submit that the present application is a novel method of playing a slot machine game, and that prior art does not show or suggest the novel features recited in Claims 29-31. Thus, Applicants respectfully request that Claims 29-31 be passed to issue. If there is any matter that would delay this Application from passing to issue, the Examiner is requested to telephone the undersigned.

Applicant strongly emphasizes that anyone reviewing the prosecution history should not interpret any of the examples Applicant has described herein in connection with distinguishing over the prior art as limiting to those specific features in isolation. Rather, Applicant asserts that it is the combination of elements recited in each of the claims, when each claim is interpreted as a whole, which is patentable.

Applicant has emphasized certain features in the claims as clearly not present in the cited references, as discussed above. However, Applicant does not concede that other features in the claims are found in the prior art. Rather, for the sake of simplicity, Applicant is providing examples of why the claims described above are distinguishable over the cited prior art.

Application No. 10/663,979


Art Unit: 3714

Applicant wishes to clarify for the record, if necessary, that the claims have been amended to expedite prosecution. Moreover, Applicant reserves the right to pursue the original subject matter recited in the present application and claims in a continuation application.

Any narrowing amendments made to the claims in the present Amendment are not to be construed as a surrender of any subject matter between the original claims and the present claims; rather merely Applicant's best attempt at providing one or more definitions of what the Applicant believes to be suitable patent protection. In addition, the present claims provide the intended scope of protection that Applicant is seeking for this application. Therefore, no estoppel should be presumed, and Applicant's claims are intended to include a scope of protection under the Doctrine of Equivalents.

For all the reasons advanced above, Applicant respectfully submits that the rejections have been overcome and should be withdrawn. And, for all the reasons advanced above, Applicant respectfully submits that the Application is in condition for allowance, and that such action is earnestly solicited.

Respectfully submitted,


Daniel M. Marks
InventorDate: 11/22/06

HIGH 5 GAMES
1200 MacArthur Blvd
Mahwah, NJ 07430
Phone: (201) 825.1711
Fax: (201) 825.1611

DIRECTIONAL WILDS

Page 9 of 9

MARKS ET AL